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| APPLICATION NO.                                     | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.                | CONFIRMATION NO.            |
|---|-------------|----------------------|------------------------------------|-----------------------------|
| 10/595,894  | 07/24/2006  | Didier Courtois      | 3712036-00735                      | 8671                        |
| 29157   | 7590        | 03/03/2010           |                                    |                             |
| K&L Gates LLP<br>P.O. Box 1135<br>CHICAGO, IL 60690 |             |                      | EXAMINER<br>MCCORMICK, MELENIE LEE |                             |
|   |             |                      | ART UNIT<br>1655                   | PAPER NUMBER                |
|   |             |                      | NOTIFICATION DATE<br>03/03/2010    | DELIVERY MODE<br>ELECTRONIC |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

chicago.patents@klgates.com

|                              |                                      |  |  |
|------------------------------|--------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/595,894 | <b>Applicant(s)</b><br>COURTOIS ET AL. |  |
|                              | <b>Examiner</b><br>MELENIE MCCORMICK | <b>Art Unit</b><br>1655                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 1,2,4-13 and 16-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3,14,15 and 19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of the species Beta in the reply filed on 17 November 2009 is acknowledged. The traversal is on the ground(s) that it would unduly limit Applicants' invention to make the election to only one individual species of the types of the raw plant materials. Moreover, Applicants argue that searching the three individual species will not place an undue burden on the Patent Office. Applicants argue that the classes to be searched would likely be the same or at least overlap for each of the species and that the Office has failed to show that separate classes would need to be searched. In addition, Applicants argue the prior art for one species will likely be applicable to the other species in the same genus as well. This is not found persuasive, as the claims have been amended to read on dried plant material from plants in three different genera. Therefore, these three different genera have distinct species therein. In the absence of evidence to the contrary, it cannot be assumed that all plants in the three genera claimed would be identical. Therefore, each genus of plant is distinct. Demonstrating a separate classification for each genus, in itself, is not the sole criteria by which distinctness is demonstrated. In addition, there would be a burden to search these three plants at once because, while Applicants state that the classes searched would likely overlap, Applicants have not demonstrated any reason why prior art which applies to one genus claimed would apply to the other genera claimed. Therefore a different search would be required for each genus claimed and this would be a serious burden.

Applicants also argue that the Patent Office needs to find only a single species of the genus for the respective claims to be anticipated. While the Examiner agrees with this, it should be noted that three genera are claimed. Therefore, in order to determine that the claims are free of the prior art, all permutations would need to be searched. Searching all permutations would be a burden.

The requirement is still deemed proper and is therefore made FINAL.

Claims 1-19 are pending.

Claims 1-2, 4-13 and 16-18 stand withdrawn.

Claims 3, 14-15 and 19 are presented for examination on the merits.

### ***Withdrawn Rejections***

The previous prior art rejections have been withdrawn in light of the amendments to the claims, which now require a raw plant material selected from the group consisting of *Daucus*, *Helianthus*, *Beta* and combinations thereof.

### ***New Rejections***

### ***Claim Rejections – 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 3, 14, 15, and 19 are rejected under 35 U.S.C. 101 because

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the claimed invention is directed to non-statutory subject matter. Claims 3, 14-15 and 19 are drawn to a product of nature. Claims 3, 14-15 and 19 read on a beet which has been dried naturally, for instance in the sun and therefore, the hand of man is evident in the claimed invention. Please note that a dried beet can be used as a food product or as a hair or skin care product because it can be consumed. The instant claims do not structurally limit the claimed food products or skin and hair care products in such a way that they do not encompass naturally occurring dried beets.

### ***Claim Rejections – 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 3, 14-15 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims recite “an effective amount of at least one raw plant material selected from the group consisting of *Daucus*, *Helianthus*, *Beta* and combinations thereof”. It is not clear what amounts would be encompassed by the phrase “effective amount” because the instant claims do not recite an intended use. Therefore, it is not clear what the plant is “effective” for. In addition, the instant specification does not provide guidance with regard to an “effective amount”. Thus, the metes and bounds of the claims cannot be determined and the claims are indefinite.

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For the purposes of applying prior art, in light of this indefiniteness with regard to an “effective amount”, any amount of Beta is deemed to meet the limitations of the instant claims.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 3, 14-15 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Weichmann (1917).

Weichmann teaches that dried beets which were dried at a temperature in the range of 40-50°C (see e.g. abstract). Weichmann also teaches that the sugar content of beets dried at a lower temperature was higher than those dried at a higher temperature (see e.g. abstract). The beets disclosed by Weichmann, therefore, read on the beets instantly claimed since they were dried at a temperature of less than 110°C. Since the beets were dried at a temperature less than 110°C, the beets (plants material) were 'processed to obtain glucosamine in an amount greater than 150 mg/kg dry matter', as claimed. Although Weichmann does not explicitly teach that the beets were dried for less than one week, it should be noted that the instant claims are drawn to a product rather than a process. Please note that “the patentability of a product does not depend upon its method of production. If the product in [a] product-by-process claim is the

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same as or obvious from a product of the prior art, [then] the claim is unpatentable even though the prior [art] product was made by a different process.” In re Thorpe, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). Once the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. In re Marosi, 218 USPQ 289, 292 (Fed. Cir. 1983). Therefore, in the absence of evidence to the contrary, the beets disclosed by Weichmann read on the product instantly claimed. The dried beets disclosed by Weichmann are orally ingestible compositions in the form of food products. In addition, nothing would preclude one from using the dried beets disclosed by Weichmann as a skin or hair care product. In order to be limiting, the intended use must create a structural difference between the claimed composition and the prior art composition. In the instant case, the intended use does not create a structural difference, thus the intended use is not limiting.

Therefore, the reference is deemed to anticipate the instant claims above.

### ***Response to Arguments***

Applicant's arguments are directed to withdrawn rejections and are therefore moot.

***Conclusion***

No claim is allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MELENIE MCCORMICK whose telephone number is (571)272-8037. The examiner can normally be reached on M-F 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on 571-272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

M.M.

/Patricia Leith/

Primary Examiner, Art Unit 1655